

REMARKS

Claims 60-349, 351, 352, 354, 355, 357, 358, 360-366, 368, 369, 371, 372 and 374-469 are pending in the present application. By this Amendment, claims 69-73 are amended and claims 74, 75, 79, 80, 84, 85, 89, 90, 94, 95, 99, 100, 104, 105, 109, 110, 114, 115, 119, 120, 124, 125, 129, 130, 134, 135, 139, 140, 144, 145, 149, 150, 154, 155, 159, 160, 164, 165, 169, 170, 174, 175, 179, 180, 184, 185, 189, 190, 194, 195, 199, 200, 204, 205, 209, 210, 214, 215, 219, 220, 224, 225, 229, 230, 234, 235, 239, 240, 244, 245, 249, 250, 253, 254, 258, 259, 263, 264, 269, 270, 274, 275, 279, 280, 285, 286, 290, 291, 295, 296, 300, 301, 305, 306, 310, 311, 315, 316, 320, 321, 325, 326, 330, and 331 are cancelled.

Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks. For the Examiner's convenience, Applicant's remarks are presented in the order in which they were raised in the Office Action.

A. Claim Amendments

Claims 60-73 are amended to replace the term "a sequence of at least 8 contiguous nucleotides" with the term "a sequence of at least 12 contiguous nucleotides." (emphasis added). Support for the amendment is found on page 26, line 21 and page 61, line 16 of the Specification. No new matter is added.

Claim 74 is cancelled as the limitation of "at least 10 contiguous nucleotides" specified in claim 74 is not within the corresponding limitation ("at least 12 nucleotides") of amended claims 60-73, from which claim 74 depends. Claim 134, which depends from claim 74 is also cancelled.

Claim 75 is cancelled as the limitation of "at least 10 contiguous nucleotides" specified in claim 74 is redundant in light of the amendments to claims 60-73, from which claim 75 depends.

Claims 79, 80, 84, 85, 89, 90, 94, 95, 99, 100, 104, 105, 109, 110, 114, 115, 119, 120, 124, 125, 129, 130, 134, 135, 139, 140, 144, 145, 149, 150, 154, 155, 159, 160, 164, 165, 169, 170, 174, 175, 179, 180, 184, 185, 189, 190, 194, 195, 199, 200, 204, 205, 209, 210, 214, 215, 219, 220, 224, 225, 229, 230, 234, 235, 239, 240, 244, 245, 249, 250, 253, 254, 258, 259, 263, 264, 269, 270, 274, 275, 279, 280, 285, 286, 290, 291, 295, 296, 300, 301, 305, 306, 310, 311, 315, 316, 320, 321, 325, 326, 330, and 331 are cancelled as they depend from claims 74 and 75.

No new matter is added by these claim amendments and cancellations.

B. Claim Rejections Under 35 U.S.C. § 102

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,101,024.

Claims 60-63, 78, 83, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,722,897.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 5,310,893.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wich.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hobart.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Giese.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sahagan.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kristo.

Claims 60-63, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chisholm.

Claims 64, 65, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Denny.

Claims 64, 65, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tabata.

Claims 64, 65, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,268,278..

Claims 66, 67, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schneider-Gaedicke.

Claims 66, 67, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Soma.

Claims 66, 67, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Valenzuela.

Claims 66, 67, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bechhofer.

Claims 68, 69, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nishikawa.

Claims 72-73, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kroeger.

Claims 72-73, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,769,326.

Claims 72-73, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP 35384.

Claims 72-73, 78, 83, 88, 103, 134, 193, 273, 284, 314 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Peterson.

Each of the rejections is based on the finding of a 9-10-mer sequence by the Examiner in polynucleotide sequences that qualify as §102 art that comprise "a contiguous sequence that is identical to a sequence of at least ... contiguous nucleotides" shown in the specification and referred to in the claims. The 9-10-mer contiguous sequences are alleged to be contained within polynucleotides that meet the other limitations of the claims (e.g., maximum size of the polynucleotide).

In response, Applicants amend claims 60-73 to replace the term " a sequence of at least 8 contiguous nucleotides" with the term " a sequence of at least **12** contiguous nucleotides." (emphasis added). Applicants submit that claims 60-73, as amended, are not anticipated by the 9-10 contiguous nucleotide sequences in the cited references.

Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §102.

CONCLUSION

In light of the arguments set forth above, Applicants earnestly believe that they are entitled to a letters patent, and respectfully solicit the Examiner to expedite prosecution of this patent application to issuance. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 223002006316. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 4, 2005.

Respectfully submitted,

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